

REMARKS

Claim 27 has been amended and claim 34 has been cancelled. Applicant acknowledges the Examiner's indication that claims 3, 34 and 36 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 1, 3-33, 35, 41, and 44-59 are presented for examination.

Applicant's representatives thank Examiners Morillo and King for their time and courtesy during an interview on May 11, 2005. In response to the Examiner's Interview Summary, Applicant's representatives agree with the Examiner's description of the substance of the interview.

**Election of Species**

Claim 27 has been amended to recite only the elected species. Applicant reserves the right to file one or more continued applications to the non-elected species. As claims 27-33 and 35 have been objected to as drawn in part to non-elected species but were indicated allowable if limited to the elected species, Applicant requests that claims 27-33 and 35 be allowed.

**Claim Rejection – 35 U.S.C. § 102**

Claims 1, 4-9, 13-21, 41, 44-47, and 50-59 are rejected under 35 U.S.C. § 102(b), and claims 10-12, 48 and 49 are rejected under 35 U.S.C. § 102(b) or 102(e), as anticipated by JP 61-133339A (JP '339). The pending independent claims are 1 and 41.

As discussed during the interview with the Examiners on May 11, 2005, claim 1 and its dependent claims are directed to medical devices. As acknowledged in the Office Action, JP '339 is directed to ornaments, such as rings, necklaces, and brooches. JP '339 does not disclose or suggest using an alloy to form a portion of the medical device, and therefore, the rejection should be withdrawn.

As further discussed during the May 11, 2005, interview with the Examiners, claim 41 was previously amended to include the features of claim 43, which was not previously rejected as anticipated by JP '339. Accordingly, this rejection should be withdrawn.

Claims 4-9, 13-21, 44-47 and 50-59 depend from claim 1 or 41, and thus are patentable over the cited references for at least the same reasons discussed above that claim 1 or 41 is patentable.

Additionally, the Examiner has asserted that various elements recited in claims 1, 10-13, 41, and 48-51, particularly Fe, Ni, Cu, Mn, Ni, P, Si, N, S and C, are in the alloy described by the JP '339 reference at least on the order of a ppm as an impurity. Applicant disputes this assertion, which appears to be in the nature of official notice, and asks the Examiner to articulate the basis for this assertion, so that it can be addressed by Applicant. Otherwise, Applicant submits that the Examiner has not provided a basis in fact and/or technical reasoning to reasonably support the determination that the cited references anticipate the claims.

### **Claim Rejections – 35 U.S.C. § 103**

Claims 22-26, which depend from claim 1, are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP '339 in view of U.S. Patent No. 5,524,338 (Martyniuk). In particular, the Action has acknowledged that JP '339 does not teach a medical device and has relied on Martyniuk for teaching a medical device.

Applicant submits that there is no motivation to combine these references. The Examiner indicates that one of skill in the art would seek to form the alloy of JP '339 into a surgical needle or microelectrode part of Martyniuk because of the teaching of Martyniuk that platinum alloys are biocompatible. Martyniuk, however, teaches no such thing, and in fact suggests the opposite. Martyniuk describes a straight needle of a platinum-iridium alloy that is “covered with a thin film coating of a dielectric material which is compatible with being implanted within a living body.” See, e.g., col. 5, lines 42-52. Such coatings are applied “so as to entirely cover the surfaces of the microelectrode” which includes the platinum-iridium needle. Col. 5, lines 57-59. Those of skill in the art, upon reading Martyniuk, would not only fail to conclude that Pt-Ir

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alloys are biocompatible, they would assume, from the fact that the alloys were coated completely with a different biocompatible material, that the alloys are not biocompatible. Thus, Martyniuk teaches away from the present claims. As such, Applicant submits that the claims are patentable over JP '339 and Martyniuk.

Applicant believes the claims are in condition for allowance, which action is requested.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

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